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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/742,714	12/20/2000	Per Johan Anders Nystrom	34646-00309USC1	9634

7590

03/17/2003

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EXAMINER

BURD, KEVIN MICHAEL

ART UNIT

PAPER NUMBER

2631

DATE MAILED: 03/17/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/742,714

Applicant(s)
NYSTROM ET AL

Examiner
Kevin Burd

Art Unit
2631



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Jan 10, 2003
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-47 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-23 and 25-47 is/are rejected.
- 7) ☒ Claim(s) 24 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. This office action, in response to the amendment filed 7/26/2002, is a final office action.

Response to Amendment

2. Applicant's arguments with respect to claims 21-23 and 25-32 have been considered but are moot in view of the new grounds of rejection.

Claim Objections

3. Claim 34 is objected to because of the following informalities: the term "Q-at-y" is disclosed on line 2. It is believed this term should be "Q-ary". Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 33-41 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable

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one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 33 recites a single method step. Donaldson 16 F.3d at 1195, 29 USPQ2d at 1850 does not affect the holding of In re Hyatt, 708 F.2d 712, 218 USPQ 195 (Fed. Cir. 1983) to the effect that a single means claim does not comply with the enablement requirement of 35 U.S.C. 112, first paragraph. As Donaldson applies only to an interpretation of a limitation drafted to correspond to 35 U.S.C. 112, sixth paragraph, which by its terms is limited to "an element in a claim to a combination," it does not affect a limitation in a claim which is not directed to a combination. A single means or a single method step is not comply with the enablement requirement of 35 U.S.C. 112, first paragraph. Claims 34-41 are rejected due to dependence on claim 33.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under treaty defined in section 351 (a) shall have the effects for the purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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7. Claims 21-23 and 25-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Atarius et al (US 6,526,035).

Regarding claim 21, Atarius discloses a CDMA transmission system. This system will comprise mobile units and base stations (figure 1). The transmission signal will comprise synchronization codes where the synchronization code appears in every time slot (column 5, lines 5-12).the synchronization code includes the shift of the long code. This component of the synchronization code is deemed the 'primary synchronization code". The number of synchronization codes will depend on the cellular system, the type of channel, etc. (column 7, lines 60-67). There will be a plurality of synchronization codes and this plurality is "about" sixteen codes. The synchronization codes will comprise a plurality of bits of information, wherein the term "Nssc_seq" equals $e^{(\text{bits of information})}$. The synchronization codes indicate the same shift as the long code. For transmission from the mobile, all information is modulated by a valid modulating sequence.

Regarding claim 22, the shift data and the synchronization code are transmitted at the same time.

Regarding claim 23, the transmission can be modulated by any valid modulating sequence.

Regarding claim 25, Atarius discloses the synchronization codes are repeated in time in each slot (column 5, lines 5-12).

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Regarding claim 26, Atarius discloses a CDMA system.

Regarding claim 27, Atarius discloses a CDMA transmission system. This system will comprise mobile units and base stations (figure 1). The transmission signal will comprise synchronization codes where the synchronization code appears in every time slot (column 5, lines 5-12). The number of synchronization codes will depend on the cellular system, the type of channel etc (column 7, lines 60-67). There will be a plurality of synchronization codes and this plurality is "about" sixteen codes. The synchronization codes will comprise a plurality of bits of information, wherein the term "Nssc_seq" equals $e^{(\text{bits of information})}$. The synchronization codes indicate the same shift as the long code. For transmission from the mobile, all information is modulated by a valid modulating sequence.

Regarding claim 28, as stated above the synchronization codes appear in every time slot (column 5, lines 5-12).

Regarding claim 29, table 1 indicates each of the synchronization codes are different.

Regarding claim 30, table 1 indicates each of the synchronization codes are different and further have correlation properties (abstract).

Regarding claim 31, the synchronization code is detected in each frame and the frame timing is based on this code.

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Allowable Subject Matter

8. Claim 24 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

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Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 33-47 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-7 and 17-19 of U.S. Patent No. 6,185,244. Although the conflicting claims are not identical, they are not patentably distinct from each other because though the claims do not state each of the plurality of code words include a plurality of symbols taken from a set of short codes, it is implied from the claim language. In addition, the reference discloses the additional limitation of "said base station transmitting said generated identification code set formed by concatenating an inner and outer code." It would have been obvious for one of ordinary skill in the art at the time of the invention to omit this step to reduce the complexity of the communication system.

Claim 33 is rejected by the reference's claim 1.

Claim 34 is rejected by the reference's claim 2.

Claim 35 is rejected by the reference's claim 3.

Claim 36 is rejected by the reference's claim 1.

Claim 37 is rejected by the reference's claim 4.

Claim 38 is rejected by the reference's claim 7.

Claim 39 is rejected by the reference's claim 5.

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Claim 40 is rejected by the reference's claim 6.

Claim 41 is rejected by the reference's claims 2 and 5.

Claim 42 is rejected by the reference's claim 17.

Claim 43 is rejected by the reference's claim 18.

Claim 44 is rejected by the reference's claim 19.

Claim 45 is rejected by the reference's claim 17.

Claim 46 is rejected by the reference's claim 18.

Claim 47 is rejected by the reference's claim 19.

Contact Information

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to:

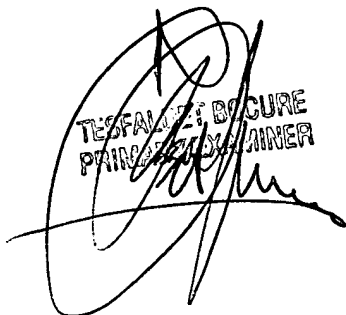
(703) 872-9314, (for formal communications intended for entry or for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

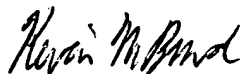
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin Burd, whose telephone number is (703) 308-7034. The Examiner can normally be reached on Monday-Thursday from 9:00 AM - 6:00 PM.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.



TESFALANEE BUCURE
PATENT EXAMINER



Kevin M. Burd
PATENT EXAMINER
March 9, 2003